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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/521,884 03/09/00 VOORT

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EXAMINER

BAKER, W

ART UNIT

PAPER NUMBER

1661

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/521,884

Applicant(s)

Van Der Voort

Examiner
Wendy Couchoud Baker

Group Art Unit
1661



☒ Responsive to communication(s) filed on Mar 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Status of Application

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It states that the instant plant was “discovered in a cultivated area **and/or** asexually reproduced”.

The declaration must state that the applicant has asexually reproduced the instant plant, such as, for example, “I state that I have invented, or discovered in a cultivated area, **and** asexually reproduced the new and distinct plant.”. Appropriate correction is required. See 37 CFR 1.162, MPEP 1604.

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

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The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Page 1, line 9, it is suggested that applicant change the word "erected" to --erect--, or similar.

B. Page 3, line 4, applicant must provide the age of the plant described in the Detailed Botanical Description, as well as the botanical/horticultural conditions such was grown under (for example, temperature, day length, light levels, fertilizer and watering rates, etc.). Further information is needed.

C. Page 3, line 17, applicant sets forth that the plant is "A single stem carrying numerous, alternately arranged pedicels". It would appear from the photographic illustration provided with the application that the plant displays numerous, alternately arranged leaves. Correction and/or clarification is required.

D. Page 3, line 20, applicant sets forth the growth habit of the instant plant as "Vigorous". Applicant should provide additional information as to the vigor of the instant plant, such as

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growth over a particular period of time and/or time to maturity, as the height of a mature plant is set forth in the specification at present.

E. Page 3, lines 21/22, applicant should provide a color chart designation for the “anthocyanin pigmentation present in spots and stripes” on the stem of the instant plant.

F. Page 4, line 1, it is suggested that applicant add the words --per plant--, or --per stem--, whichever is accurate, after the recitation “45”, in order to clarify the information set forth.

G. Applicant should import into the specification information regarding the specific botanical features of the instant plant such as leaf apex shape, leaf base shape, bulb shape, a botanical descriptor for bud shape (the recitation “Tapering like a lancet” is insufficient in this regard), bud diameter, tepal length, width and shape for the inner and outer tepals, pedicel diameter, and information regarding the seeds of the instant plant, such as whether the plant sets seed, amount of seed set and seed color, size, shape and fertility.

H. Applicant should provide color designations and/or supplement the general color descriptions currently set forth with color designations from the employed color chart, for such characteristic botanical features as foliage (upper and lower surface), stem, color chart color for the “gray shading” on the flower bud, bulb color, flower mid-vein color, color of the “dark purple

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spots and markings” on the blooms of the instant plant, pedicels, anther, filament, pollen and pistil.

I. Applicant should provide the time it takes for the buds to unfurl and/or the typical and observed environmental conditions needed for bloom, if available.

J. Page 4, line 20, applicant should clarify what the flower size set forth is intended to indicate, (for example, diameter, depth, etc.) and provide flower depth and/or diameter, if not indicated in the specification at present.

K. In addition to providing the typical and observed height of the instant plant, applicant should provide the spread (width or diameter) of the instant plant at a given age and location of culture.

L. If available, additional information relative to plant disease/pest resistance/susceptibility, should be set forth in the specification. Information provided should specify whether the resistant/susceptible character is a general characteristic of the species, or if the instant plant is resistant/susceptible to diseases/pests as compared to the species as a whole. Page 5, line 11, applicant sets forth that the bloom of the instant plant displays a “Medium” resistance to disease,

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but fails to indicate which disease(s) the blooms show resistance to, and fails to provide information regarding the resistance of the plant as a whole.

M. Applicant sets forth that the instant plant is fragrant. Applicant should describe the fragrance of the instant plant, if possible. Typical descriptions might be: Strong and sweet, Light, lemony, etc.

N. Applicant import into the specification information regarding the lastingness of the individual bloom for the flowers of the instant plant.

O. If available, applicant should set forth information regarding the cold hardiness of the instant plant.

P. Page 5, applicant sets forth the length of the stamens and anthers as "Short to medium, depending on cultivation conditions", but fails to specify whether it is the anthers or the filaments that are "short to medium", and fails to specify what the cultivation conditions that would cause the length to vary are. Further information is needed.

Q. The designation(s) for flower bud and flower color set forth in the specification do not reasonably correspond with the color(s) illustrated. Specifically, the illustrated flower buds

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appear to be a light green color before they are the 66D pink color recited. Additional information regarding the light green color of less mature flower buds is required. In addition, the flowers appear to have bright orange and bright yellow shading along the middle of the petals in addition to the green midvein mentioned in the specification and the RHS 66C petal color set forth. Further information is needed.

If the source of the noted discrepancies is due to photographic error, it may be necessary for applicant to file a substitute photographic illustration (properly mounted and in duplicate) which more reasonably corresponds to the color designations set forth in the specification or else attempt to somehow account for same. The colorations illustrated and the color designations in the specification must reasonably correspond to each other and must faithfully set forth/depict the true and characteristic features of the plant.

R. During a search of UPOV-ROM, the following "hits" on a **hybrid lily** cultivar named 'Corso' were found: **ZA PBR 2917, PL PBR LIO0067, NL PBR LEL1580, DE PBR LIU 00108, BE PBR 25266**, While these previous foreign filings would appear to be drawn to the same plant given the limited information available on UPOV-ROM, it cannot conclusively or positively be determined that such is the case.

Applicant must substantively address and obviate this issue responsive to this Office Action (so as to provide as complete a description of the plant as is reasonably possible) by one of the two avenues mentioned below:

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(1) If the above are indeed all drawn to the same plant as is presently described and illustrated (i.e. the instant plant), such needs to be positively and clearly acknowledged in applicant's comments responsive to this Office Action. In the alternative, applicant could file a substitute declaration incorporating these prior foreign filings so as to clarify the issue should such be found to be the case, even though foreign priority is not being claimed; or

(2) If any/all above referenced foreign documents refer to a different **hybrid lily** cultivar named '**Corso**', it would be necessary for applicant to take corrective action relative to the cultivar name of the plant presently described and illustrated (i.e. the "instant" plant) such as by correcting same, as reuse of the cultivar name '**Corso**' would then be inadmissible under at least Article 48, Article 50 and Article 51 of the International Code of Nomenclature for Cultivated Plants - 1980.

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be acceptable.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

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Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the oath/declaration.

References Cited

The references cited on the attached PTO-892 are made of record to show the state of the art, and are believed to be the same cultivar as the claimed plant.

Drawing Changes

Applicants are advised of the changes to 37 CFR 1.84 which took effect November 29, 2000. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on bristol board, paper or other material.

Further information on the new rules is available on the USPTO web site at www.uspto.gov.

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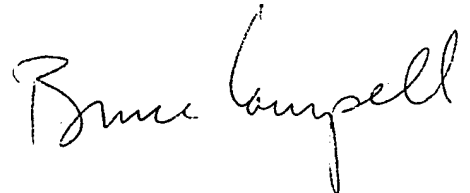
Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Baker whose telephone number is (703) 308-8898. The Examiner's current work schedule is available at the above telephone number.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Baker



**BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**